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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,710	07/15/2002	Graeme Deaker	TJK/216	3993

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SEYFARTH SHAW LLP
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EXAMINER

ABDI, KAMBIZ

ART UNIT	PAPER NUMBER
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3621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/069,710

Applicant(s)

DEAKER ET AL.

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on August 18, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

- Claims 1-4, 14, 22-25, 30-34, and 36-39 are amended.
- Claim 5, 35, 40 is canceled.
- New claims 41-42 were added
- Claims 1-4, 6-34, and 41-42 are pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 18, 2006 has been entered.

Response to Arguments

3. Applicant's arguments filed August 18, 2006 have been fully considered but they are not persuasive for the following reasons:

4. In response to applicant argument regarding rejection of Claims 1-4 and 6-40 under 35 U.S.C. § 103 as being obvious over the prior art used in the rejection. The examiner believes that the argument that the applicant has put forward on regards to claims are not persuasive to overcome the prior art of record used in the rejection.

5. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "gif voucher", on-line, off-line, "stored value instrument", coupons, etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See

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In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant has argued that the prior art of record does not show the specifics of a gift voucher (gift certificate). However, none of the claims do recite such phrase as "gift voucher", as a matter of fact the claims specifically claim "goods/services voucher" (coupon) which have been replaced by the phrase "a stored value instrument" that there is no support for in the specification, therefore, the rejection is proper and is sustained. As for the method of using such "goods/services voucher" (coupon) "via a plurality of pathways", the phrase does not relay the meaning the applicant has in mind, as in the ordinary meaning of the phrase in the art is clearly the electronic pathways such as different lines of communications, it would be almost inherent and one skilled in the art would know that multiple paths are used for transfer of the information in an electronic network such as the internet or any other network.

6. As for the argument that applicant has put forward in regards to complexity of the prior art, it should be noted that the process of the prior art is functionally equivalent to what is claimed by the applicant and the complexity or simplicity of such system has no bearing on the patentability of a claimed invention. Unless the differences produce unexpected, concrete, and tangible results..

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 1-4, 6-34, and 41-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner has reviewed the specification and has not been able to find in any part within the specification that would support the phrase "stored value instrument". Clarification is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 6-34, and 41-42 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,193,155 to Jay S. Walker et al.

9. Regarding claims 1 and 34, Walker et al. (See abstract, figures 1-8, 11-14B) disclose method for issuing a stored value instrument (Gift Certificate, figure 8) bearing a randomly selected token (element 818 figure 5, any of elements 510, 520 or 512) recorded in a database and subsequently compared with presented token upon redemption for goods or services substantially as claimed. The differences between the above and the claimed invention is the use of specific terms token and voucher (See Walker column 3, line 31-column 4, line 17, column 5, lines 25-59, column 7, lines 29-46, column 8, lines 53-64, column 9, lines 24-37, column 10, lines 41-67 and column 11, lines 1-12).

10. As per claims 2-4, 6-33 and 41-42, Walker et al clearly teaches all the limitations of claims 1 and 34 and further discloses all the limitations as they have provided in claims 2-4, 6-33 and 41-42 as been disclosed and are substantially as claimed by Walker in figures 5-8 and 12-14B and column 3, line 31-column 4, line 17, column 5, lines 25-59, column 7, lines 29-46, column 8, lines 53-64, column 9, lines 24-37, column 10, lines 41-67 and column 11, lines 1-12.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 3 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented

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and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

12. Claims 1-4, 6-34, and 41-42 are rejected under 35 U.S.C. 3 103 as being unpatentable over Fortenberry et al (WO 99/30256) in view of any of Manasse (WO 97/03423(both cited by applicant), Scroggie et al {6014634} or Jacoves et al (6741968).

13. Regarding claim 1, Fortenberry et al (See abstract, Figs. 1-4, pages 2,3, page 5, lines 1-40 claims 1-15) disclose method for issuing an electronic coupon recorded in a database and subsequently compared with it upon redemption for goods or services substantially as claimed. The differences between the above and the claimed invention is the use of specific terms token and voucher. It is noted that it is believed that coupons are functionally equivalent to a token/voucher. Each of Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1,5, 10-13,15-18) or Jacoves et al (See abstract, Figs. 2,8, 10, 25) show network distributed tokens or vouchers for goods or services. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Fortenberry et al because the coupon incentives are conventional functional equivalents with respect to the claim limitations and electronic network distribution is standard delivery for any digital content.

14. Regarding the network limitations of claim 2, Fortenberry et al (See abstract, Figs.. 1-4, pages 2,3, page 5, lines 1-40 claims 1-15) disclose issuing an electronic coupon recorded in a database over a network and subsequently compared with same upon redemption for goods or services which is a functional equivalent of the claim limitations.

15. Regarding the delivery limitations of claim 3, Fortenberry et al (See abstract, Figs. 1-4, pages 2,3, page 5, lines 1-40 claims 1-15) disclose issuing an electronic coupon recorded in a database over a network and subsequently compared with same upon redemption for goods or services which is a functional equivalent of the claim limitations.

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16. Regarding the order limitations of claim 4, Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), 'Scroggie et al (See abstract, Figs. 1,5, 10-13,15-18) or Jacoves et al (See abstract, Figs. 2,8, 10, 25) show network distributed tokens or vouchers for goods or services including web linked processing, which is a functional equivalent of the claim limitations.
17. Regarding the order limitations of claims 5, Manasse (see 'abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1, 5, 10-13,15-18) or Jacoves et al (See abstract, Figs. 2,8, 10, 25) show network distributed tokens or vouchers for goods or services including web linked processing which is a functional equivalent of the claim limitations.
18. Regarding the web limitations of claims 6, Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1,5, 10-13,15-18) or Jacoves et al (See abstract, Figs. 2,8, 10, 25) show network distributed tokens or vouchers for goods or services including web linked processing which is a functional equivalent of the claim limitations.
19. Regarding the web limitations of claims 7, Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1, 5, 10-13,15-18) or Jacoves et al (See abstract, Figs. 2,8, 10, 25) show network distributed tokens or vouchers for goods or services including web linked processing which is a functional equivalent of the claim limitations.
20. Regarding the web limitations of claim 8, Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1,5, 10-13,15-18) or Jacoves et al (See abstract, Figs. 2,8, 10, 25) show network distributed tokens or vouchers for goods or services including web linked processing which is a functional equivalent of the claim limitations.
21. Regarding the user limitations of claim 9, Fortenberry et al (See abstract, Figs. 1-4, pages 2,3, page 5, lines 1-40 claims 1-15) disclose issuing an electronic coupon recorded in a database over a network and subsequently compared with same upon redemption for goods or services which is a functional equivalent of the claim limitations.
22. Regarding the network limitations of claim 10, Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1, 5, 10-13,15-18) or Jacoves et al

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(See abstract, Figs. 2, 8, 10, 25) show network distributed tokens or vouchers for goods or services including web linked processing which is a functional equivalent of the claim limitations.

23. Regarding the beneficiary limitations of claim 11, Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1, 5, 10-13, 15-18) or Jacoves et al (See abstract, Figs. 2, 8, 10, 25) show network distributed tokens or vouchers for goods or services including web linked processing which is a functional equivalent of the claim limitations because manufacturers distribute coupons electronically to a plurality of customers.

24. Regarding the redemption limitations of claims 12-20, Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1, 5, 10-13, 15-18) or Jacoves et al (See abstract, Figs. 2, 8, 10, 25) show network distributed tokens or vouchers for goods or services including web linked processing which is a functional equivalent of the claim limitations.

25. Regarding the processing limitations of claims 21-24, Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1, 5, 10-13, 15-18) or Jacoves et al (See abstract, Figs. 2, 8, 10, 25) show network distributed tokens or vouchers for goods or services including web linked processing which is a functional equivalent of the claim limitations because these are no more than the standard processing of coupons.

26. Regarding the image limitations of claims 25-28, Scroggie et al (See abstract, Figs. 1, 5, 10-13, 15-18) show network distributed tokens or vouchers for goods or services including web linked processing including image (See Fig. 11) which is a functional equivalent of the claim limitations because these are no more than the standard processing of coupons.

27. Regarding the delivery limitations of claims 29-33, Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1, 5, 10-13, 15-18) or Jacoves et al (See abstract, Figs. 2, 8, 10, 25) show network distributed tokens or vouchers for goods or services including web linked processing and email which is a functional equivalent of the claim limitations.

28. Regarding claim 34, Fortenberry et al (See abstract, Figs. 1-4, pages 2, 3, page 5, lines 1-40 claims 1-15) disclose a means for issuing an electronic coupon recorded in a database and subsequently compared with it upon redemption for goods or services substantially as claimed. The differences between

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the above and the claimed invention is the use of specific terms token and voucher. It is noted that it is believed that coupons are functionally equivalent to a token/voucher. Each of Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1,5, 10-13,15-18) or Jacoves et al (See abstract, Figs. 2,8, 10, 25) show network distributed tokens or vouchers for goods or services. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Fortenberry et al because the coupon incentives are conventional functional equivalents with respect to the claim limitations and electronic network distribution is standard delivery for any digital content.

29. Regarding claim 35, Fortenberry et al (See abstract, Figs. 1-4, pages 2,3, page 5., lines 1-40 claims 1-15) disclose a means for issuing an electronic coupon recorded in a database and subsequently compared with it upon redemption for goods or services substantially as claimed. The differences between the above and the claimed invention is the use of specific terms token and voucher. It is noted that it is believed that coupons are functionally equivalent to a token/voucher. Each of Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1,5, 10-13,15-18) or Jacoves et al (See abstract, Figs. 2,8, 10, 25) show network distributed tokens or vouchers for goods or services. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Fortenberry et al because the coupon incentives are conventional functional equivalents with respect to the claim limitations and electronic network distribution is standard delivery for any digital content.

30. Regarding the bank limitations of claims 36-39, Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12). show network distributed tokens or vouchers for goods or services including web linked processing in an electronic bank equivalent which is a functional equivalent of the claim limitations.

31. Regarding claim 41-42, Fortenberry et al (See abstract, Figs. 1-4, pages 2,3, page 5, lines 1-40 claims 1-15) disclose a means for issuing an electronic coupon recorded in a database and subsequently compared with it upon redemption for goods or services substantially as claimed. The differences between the above and the claimed invention is the use of specific terms token and voucher and further obtaining

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such voucher or coupon by redeeming royalty units. It is noted that it is believed that coupons are functionally equivalent to a token/voucher. Each of Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1,5, 10-13,15-18) or Jacoves et al (See abstract, Figs. 2,8, 10, 25) show network distributed tokens or vouchers for goods or services. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Fortenberry et al because the coupon incentives are conventional functional equivalents with respect to the claim limitations and electronic network distribution is standard delivery for any digital content as well as it is well known in the art to redeem points and miles for obtaining value bearing instruments such as airline tickets for the motivation of convenient and customer loyalty.

32. Examiner's Note: Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual-claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Conclusion

33. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to **Kambiz Abdi** whose telephone number is **(571) 272-6702**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **(571) 272-6712**.

34. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see

<http://portal.uspto.gov/external/portal/pair>.

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35. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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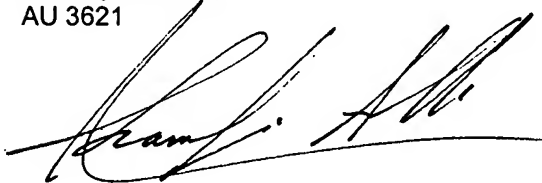
(571) 273-8300 [Official communications; including After Final communications labeled "Box AF"]

(571) 273-6702 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Examiner in the

Knox Building, 50 Dulany St. Alexandria, VA.

Kambiz Abdi
Primary Examiner
AU 3621

A handwritten signature in black ink, appearing to read 'Kambiz Abdi', written over a horizontal line.

**KAMBIZ ABDI
PRIMARY EXAMINER**

March 1, 2007